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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/876,090	06/07/2001	Mark Andrew Benny	AUS9-2001-0209-US1	9388

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01/11/2007

EXAMINER

OSMAN, RAMY M

ART UNIT PAPER NUMBER

2157

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/11/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 09/876,090	Applicant(s) BENNY, ET AL	
	Examiner Ramy M. Osman	Art Unit 2157	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. This action is responsive to amendment filed on October 27, 2006. Claims 22-25 are pending examination.

Response to Arguments

2. Applicant's arguments, filed 10/27/2006, with respect to the rejection(s) of claim(s) 22-25 under 102 (e) have been fully considered and are not persuasive.

3. Applicant argues that claims 22-24 constitute statutory subject matter.

In reply, Applicant has merely repeated the language of the claims while failing to demonstrate how the claims are statutory. Applicant has not sufficiently addressed how the claims are not an abstract idea, and how the claims are not a program per se. Furthermore, Applicant has not amended the claims to overcome this rejection.

4. Applicant has not responded to the Provisional Double Patenting Rejection and therefore the rejection is maintained.

5. Applicant argues that Hill does not disclose each limitations in the claimed invention.

In reply, Applicants claim language is very broad. The claims are broadly interpreted where Hill satisfies anticipation of the claims. Regarding the limitation of "*determining a solution scope for the technical framework to be created, the solution scope guided by an information technology services contact with the customer, the solution scope based on common practices for delivering certain types of information technology services*", this is interpreted as Hills teaching of utilizing a computer program for representing an IT infrastructure of an

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organization into an interactive user interface. *“determining a solution scope for the technical framework to be created”* is interpreted as Hills teaching of representing an IT infrastructure.

“the solution scope guided by an information technology services contact with the customer, the solution scope based on common practices for delivering certain types of information technology services” is interpreted as being inherent in Hills teachings since the organization (i.e.

“customer”) that is utilizing the program will have a service agreement (i.e. permission to use the software) when it implements *“determining a solution scope”*. The *“common practices”* are the steps of the program. (column 1 line 53 – column 2 line 10 and column 3 lines 10-65)

Regarding the limitation of *“mapping the customer's existing equipment to lowest level abstractions of architectural building blocks in a technical model”* Hill discloses mapping information technology elements and organizational elements (i.e. *“customers equipment”*) into a hierarchical list. Regarding *“the technical model describing people, processes, tools and information used to deliver specific services to customers”*, these are all inherent in the information technology elements and the organizational elements. *“the architectural building blocks comprising architectural components that are sufficiently modular and bounded to be described as self-contained entities”* is also anticipated by Hill since each element is inherently within itself a *“self-contained entity”*. (column 4 lines 35-55, column 6 line 64 – column 7 line 10 and column 9 lines 1-55)

Regarding *“creating a list of design objects as a function of the solution scope for the technical framework, the design objects based on logical groupings of architectural building blocks, including software and hardware components”*, this is also interpreted as Hills teaching of the hierarchical list as mentioned above. And regarding *“designating relationships between*

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the design objects as a function of the solution scope and the specific set of information technology services for the customer", this is interpreted as Hills teaching of establishing the representations for the information technology infrastructure. (column 4 lines 1-7).

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 22-24 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. *MPEP Section 2106(IV)(C)(2)(B)(2)(b)* mentions that a statutory computer process is determined not by how the computer performs the process, but by what actions the computer performs to achieve a practical application with a useful, concrete and tangible result. The mentioned "technical framework" is an abstract idea which has not been sufficiently contextualized to appear as a practical application with a useful, concrete and tangible result. Furthermore, the claims appear to be a program per se which consists of software instructions without a tangible output result that is conveyed to a user in a real-world application of the tangible results. Independent claims 22-24 are non-statutory because applicant is claiming an intangible software program per se and because they do not claim a practical application with a tangible result. (*see MPEP Section 2106(IV)(C)*).

Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined

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application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 22-25 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-23 of copending Application No.

09/875,863.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present invention is directed to a method for creating a technical framework for use in delivering a specific set of information technology services for a customer, while the pending application is directed to a method for designing an enterprise service delivery technical framework for a customer. Furthermore, both applications are directed to concepts for determining a solution scope, mapping existing customer information to architectural building blocks of a service delivery technical model, and designating relationships between design objects as a function of the solution scope.

For at least these reasons, it would have been obvious for one of ordinary skill in the art that the concepts for creating a technical framework for use in delivering a specific set of information technology services for a customer, and designing an enterprise service delivery

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technical framework for a customer of the present invention as in the application, are not patentably distinct in so far as the specifications of each application support the identical critical features noted above.

10. Claims 22-25 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 25-30 of copending Application No. 09/875,865.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present invention is directed to a method for creating a technical framework for use in delivering a specific set of information technology services for a customer, while the pending application is directed to a method for using an enterprise service delivery technical model to develop a technical framework to provide System Management services to a customer. Furthermore, both applications are directed to concepts for determining a solution scope, mapping existing customer information to architectural building blocks of a service delivery technical model, and designating relationships between design objects as a function of the solution scope.

For at least these reasons, it would have been obvious for one of ordinary skill in the art that the concepts for creating a technical framework for use in delivering a specific set of information technology services for a customer, and designing an enterprise service delivery technical framework for a customer of the present invention as in the application, are not patentably distinct in so far as the specifications of each application support the identical critical features noted above.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 22-25 rejected under 35 U.S.C. 102(e) as being anticipated by Hill et al (US Patent No 6,670,973).

Hill teaches a method, a technical framework, a computer readable medium comprising a program, and a data processing system all correspondingly and operable to deliver a specific set of information technology services for a customer, comprising the steps of:

determining a solution scope for the technical framework to be created, the solution scope guided by an information technology services contact with the customer, the solution scope based on common practices for delivering certain types of information technology services (see at least, column 1 line 53 – column 2 line 10 and column 3 lines 10-65);

mapping the customer's existing equipment to lowest level abstractions of architectural building blocks in a technical model, the technical model describing people, processes, tools and information used to deliver specific services to customers, the architectural building blocks comprising architectural components that are sufficiently modular and bounded to be described as self-contained entities (see at least column 4 lines 35-55, column 6 line 64 – column 7 line 10 and column 9 lines 1-55);

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creating a list of design objects as a function of the solution scope for the technical framework, the design objects based on logical groupings of architectural building blocks, including software and hardware components (see at least column 3 line 34 – column 4 line 35 and column 9 lines 1-55); and

designating relationships between the design objects as a function of the solution scope and the specific set of information technology services for the customer (see at least column 4 lines 1-7).

Conclusion

13. Applicant is advised that the above specified citations of the relied upon prior art are only representative of the teachings of the prior art, and that any other supportive sections within the entirety of the reference (including any figures, incorporation by references, and claims) is implied as being applied to teach the scope of the claims.

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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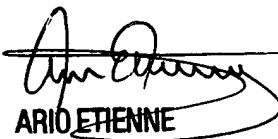
however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ramy M. Osman whose telephone number is (571) 272-4008. The examiner can normally be reached on M-F 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272-4001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

RMO
January 6, 2007


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